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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,949	01/07/2002	Menzo Havenga	2183-5226US	5172

24247 7590 06/03/2004

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EXAMINER

MARVICH, MARIA

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/040,949

Applicant(s)

HAVENGA ET AL.

Examiner

Maria B Marvich, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 3-16, 18-23 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Claims 2 and 17 have been cancelled in a preliminary amendment filed 1/7/2002.

Claims 1, 3-16 and 18-23 are pending in this application and subject to restriction.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1 and 3-16, drawn to a to a gene delivery vehicle and a method of delivering a nucleic acid of interest to a host cell using a gene delivery vehicle, classified in class 424, subclass 93.2 and class 435, subclass 456.
- II. Claims 18-19, drawn to a receptor and/or binding site for adenovirus D and/or F associated with CAR negative cells, classified in class 530, subclass 350.
- III. Claim 20-21, drawn to a capsid protein derived from adenovirus D and/or F, classified in class 530, subclass 350.
- IV. Claim 22-23, drawn to an isolated or recombinant nucleic acid encoding a capsid protein, classified in class 435, subclass 69.1

The inventions are distinct each from the other because of the following reasons:

The gene delivery vehicle of Group I, the receptor of Group II, the capsid protein of Group III and nucleic acid of Group IV are distinct both physically and functionally from one another and therefore have different modes of operation, different functions and different effects. Therefore, the inventions of the different groups are capable of supporting separate patents.

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The products of Group II-IV are distinct from the method of Group I because the products cannot be used directly in the method as claimed. For example, the method of Group I does not use the receptor of Group III, independent of the cell to which it is associated. The isolated nucleic acid of Group IV can be used for synthesis of the capsid protein of Group II. However, neither the nucleic acid nor the capsid protein independent of the gene delivery vehicle is used in the method of Group I. Therefore, the inventions of Group I-IV are capable of supporting separate patents.

The searches required for the different groups are not coextensive. These inventions are distinct for the reasons given above and have acquired a separate status in the art, Group I (424/93.2; 435/456) versus Group II and Group III (530/350) versus Group IV (435/69.1). Furthermore, the searches for art pertaining to receptors and/or binding sites for adenovirus D and/or F associated with CAR negative cells is not coextensive with a search for art pertaining to capsid proteins derived from adenovirus D and /or F. Therefore, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon cancellation of claims to a non-elected inventions, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Conclusion*

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (571)-272-0774. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (571)-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maria B Marvich, PhD

Examiner

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**GERRY LEFFERS**  
**PRIMARY EXAMINER**

May 17, 2004